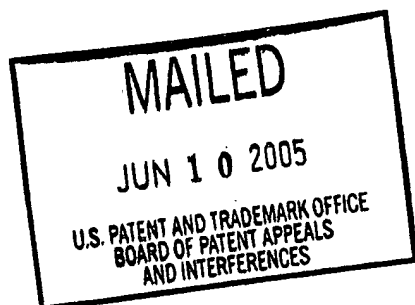


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Ex parte LINDA ROSKIN

Appeal No. 2005-1238
Application No. 09/874,031

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 and 7 to 22, which are all of the claims pending in this application.¹

We REVERSE.

¹ This application was previously before this panel in Appeal No. 2003-1855. In our decision mailed September 17, 2003 we reversed the rejections of claims 5 to 22 under 35 U.S.C. § 103. Thereafter, the examiner reopened prosecution in an Office action mailed October 30, 2003. However, that Office action does not indicate the Technology Center (TC) Director's authorization to reopen prosecution under 37 CFR § 1.198 as required by Manual of Patent Examining Procedure (MPEP) § 1214.04.

BACKGROUND

The appellant's invention relates to devices and methods that are used to divide a container into sections so that the container can better be used to hold a designed floral arrangement. More particularly, the present invention relates to partitioned covers for vases, and other traditional flower holding containers, that assist in the formation of a floral design (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellant's brief. Claims 11, 19 and 22, the independent claims on appeal, read as follows:

11. An assembly, comprising:
 - a container having an open top end with a predetermined maximum width;
 - an elastomeric cover element for covering said open top end, said cover element having an unstretched width that is smaller than said maximum width of said open top end wherein said cover element must be elastically stretched to a stretched width greater than said maximum width of said open top end to cover said open top end; and
 - a grid pattern of openings defined in said cover element, said grid pattern having multiple rows and multiple columns, wherein multiple openings are arranged in each of said rows and each of said columns.
19. A method of preparing a vase for a floral arrangement, wherein the vase has an open top with a maximum width at least one point, said method comprising the steps of:
 - providing an elastomeric cover, containing a plurality of openings that are arranged in a grid pattern of multiple rows and multiple columns, wherein said elastomeric cover has a width that is less said maximum width of said vase, and wherein multiple openings are present in each of said rows and said columns;
 - stretching said elastomeric cover over said open top of said vase, wherein said width of said elastomeric cover elastically increases to a width greater than that of said vase and engages said vase around said open top.

22. A floral arrangement cover for a vase, wherein the vase has an open top, said cover comprising:
- an elastic planar top surface in which are defined a plurality of openings that are arranged in a grid pattern of multiple rows and multiple columns, wherein multiple openings are disposed within each of said rows and said columns;
 - an elastic peripheral wall that extends downwardly from said planar top surface, said elastic planar top and said elastic peripheral wall being elastically stretchable to a stretched size where said peripheral wall can receive the open top of the vase therein and said elastic planar top spans the open top of the vase, wherein said peripheral wall engages the vase around the open top by contracting around the open top.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Saks et al. (Saks)	2,876,587	Mar. 10, 1959
McElroy	4,901,881	Feb. 20, 1990
Turner	EP 0 182 453 A1	May 28, 1986

Claims 5, 7, 9 to 15 and 17 to 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Turner in view of McElroy.

Claims 8 and 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Turner in view of McElroy and Saks.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (mailed May 26, 2004) and the answer (mailed December 6, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed October 28, 2004) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 5 and 7 to 22 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be

sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on 35 U.S.C. § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., Grain Processing Corp. v. American Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

With this as background, we analyze the prior art applied by the examiner in the rejection of the claims on appeal.

Turner's invention is related to the protection of potted growing plants during shipping. As shown in Figure 1, a plant 5 is planted or grown in a pot 16 in potting soil 6 covered with a relatively thin layer of fibrous bedding material 7, usually about one-half to one and one-half inches thick, to hold the potting soil in place during shipping of the potted plant. An open-mesh cover 10 is placed over and against the layer of bedding material and secured to the pot to hold the bedding material, and thus the potting soil, in place.

In one of Turner's embodiments, the open-mesh cover comprises a set of one-sixteenth inch diameter plastic rods spaced one inch apart and-fastened to a second set of such rods having their longitudinal axis at an angle of about 90 degrees from the longitudinal axis of the first set of rods. In this embodiment, the pot is provided with a lip extending around the inside surface of the pot near its top. The open-mesh cover is trimmed to fit inside the pot and snapped into place beneath the lip.

Turner's preferred embodiment of open-mesh cover is shown in Figures 2 and 3. This cover comprises a ring 10 of O-shaped cross-section as shown in Figure 3 having

a size and shape such that when inverted it fits over the upper rim 14 of the pot 16 and is held securely in place by a snap-lock mechanism shown in Figure 3. Turner teaches (page 4, lines 28-31) that "[a]ny other suitable means may be employed for securing the ring 10 to the top of the pot 16, and is easily provided by persons having skill in the art." The open-mesh portion of the cover is formed by attaching filaments 12 to the ring 10 about one-half to 1.5 inch apart. Plastic filaments are preferred elements for forming the open-mesh cover; however, ribbons, rods, wires, etc., may also be used.

McElroy's invention provides a method and apparatus for rapidly and simply closing containers, especially disposable containers such as beverage containers having varying sized openings. McElroy's invention provides an elastic container lid which is stretchably adjustable to cover container openings of known various sizes. The lid is typically made of an elastomeric material (i.e., a material which may be stretched to accommodate container openings of various sizes and which at the same time maintains its resiliency such that it will return substantially to its original form after stretching). The lid includes a closure panel to be extended over such an opening. For container openings of known sizes, the closure panel of the lid is sized to be smaller in dimension in an unstretched condition than the smallest of the known container opening sizes so that the closure panel must be stretched to cover the smallest of such known container openings in use. The lid further includes a gripping zone proximate the

periphery of the closure panel wherein the lid is stretchable to allow engagement of the gripping zone with an opening wall of the container opening to cause the lid to grip and seal the container opening. The lid may include an aperture means for receiving a drinking straw wherein the aperture means is sized to snugly receive such a straw when the closure panel is in the stretched position.

Figures 7 and 8 of McElroy show a container 30 which may comprise any of a number of known containers for holding solid or liquid materials. In the preferred embodiment, the container is typically comprised of a disposable cup such as found in fast food restaurants or in convenience store locations. The container 30 includes a lid 10 which is resiliently stretched over the container opening such that the gripping zone 14 of the lid 10 is engaged with a container wall 32 defining a container opening 34 at the top of the container 30. The lid 10 is resiliently stretched over the container opening 34 and the lid is released so that the resiliency of the lid 10 engages the lid in position over the container opening 34.

Saks' invention relates to a candlestick flower arranger. As shown in Figures 1-4, a candlestick holder 10 having a base portion 11 with a finger grip portion 12 thereon and an upstanding portion 13 having an opening 14 with a tapered lower end 15 into which the lower end of a candle 16 is seated and retained in the usual manner.

With the candle in place, there is fitted a container 16' over the candle and slid downwardly for support upon the upper end of the upstanding portion 13 of the candlestick holder. This container has a central tubular upstanding sleeve portion 17 providing a vertical opening 18 to accommodate the candle 16. The upstanding sleeve portion 17 extends upwardly beyond the upper edge of flange 20 to accommodate a separate annular shaped grill or perforated member 21 having a central opening 22 adapted to receive the upper end of the sleeve portion 17 and sufficiently wide to extend over the flange 20 and rest thereupon. This member 21 is also preferably made of plastic or transparent material. The opening 22 has diametrically opposed notches 23 and 24 adapted to respectively permit the member 21 to be set over diametrically-opposite radially-extending projections 25 and 26 on the upper end of the sleeve portion 17. After the member 21 is in place and has been rotated slightly so that the notches are out of registry with the projections 25 and 26, the member 21 is locked upon the flange 20 of the container and held against disengagement therefrom. With the container 16' in place upon the candlestick holder, the same can be partly filled with water and thereafter the grill member 21 can be fitted over the sleeve portion 17 and rotated to be locked under the projections 25 and 26. With the member 21 in place and the arranger fully assembled upon the candlestick, flower stems 27 can be inserted through any one of a plurality of holes 28 in the member 21 and into the water contained therein.

In the rejection of independent claims 11, 19 and 22 before us in this appeal (final rejection, p. 2), the examiner (1) set forth an accurate assessment as to the teachings of Turner; (2) set forth an inaccurate assessment as to the teachings of McElroy;² (3) ascertained³ that Turner does not teach the claimed elastomeric cover; and (4) concluded that:

It would have been obvious to one of ordinary skill in the art to modify the teachings [of Turner] at the time of the invention with the teachings of an elastomeric cover to accommodate different size container/vases as taught by McElroy (McElroy Col. 2 line 14-21, Col. 1 line 11, and Col.8 line 40) since the modification is merely the selection of a known alternate equivalent cover means.

The appellant argues in the brief that there is no teaching, suggestion or motivation in the applied prior art (i.e, Turner, McElroy and Saks) for a person of ordinary skill in the art, at the time the invention was made, to have modified Turner to arrive at the subject matter of independent claims 11, 19 and 22. We agree. In that regard, it is our view that the teachings of McElroy would not have provided an artisan with any reason to have modified Turner's cover to be an elastic cover as set forth in independent claims 11, 19 and 22. As in the previous appeal, the mere fact that the

² The examiner stated (final rejection, p. 2) that "McElroy teaches a floral arrangement cover for a vase." McElroy does not teach or suggest that his lid is a floral arrangement cover for a vase.

³ After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the applied prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, the applied prior art does not suggest the desirability of the modification. Additionally, it appears to us that making Turner's cover 10 to be an elastic cover stretched over the pot 16 would effectively destroy the purpose of Turner's cover which is to hold the bedding material, and thus the potting soil, in place. To perform that function, the cover must depend downwardly inside the pot to engage the upper surface of the bedding material which is located below the open top end of the pot. If Turner's cover 10 were modified to be an elastic cover stretched over the pot 16, it would not be able to then depend downwardly inside the pot to engage the upper surface of the bedding material to hold the bedding material, and thus the potting soil, in place.


For the reasons set forth above, the decision of the examiner to reject independent claims 11, 19 and 22, and claims 5, 7 to 10, 12 to 18, 20 and 21 dependent thereon, under 35 U.S.C. § 103 is reversed.


CONCLUSION

To summarize, the decision of the examiner to reject claims 5 and 7 to 22 under 35 U.S.C. § 103 is reversed.

REVERSED


CHARLES E. FRANKFORT
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JENNIFER D. BAHR
Administrative Patent Judge

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